REMARKS

In view of the above amendments and following remarks, reconsideration and further examination are requested.

Initially, replacement formal drawings for Figs. 26 and 27 have been provided so as to make these figures consistent with their description in the original specification. Specifically, these figures show the chuck-to-chuck distance to be --5 mm -- instead of "30 mm", while also showing the pull rate to be -- 500 mm/min-- instead of "100 mm/min". Paragraphs [0094] and [0107] of the substitute specification have been correspondingly amended.

In section 1 on pages 2-4 of the Office Action, the Examiner has rejected claims 22-43 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

A first basis for this rejection is that the Examiner believes that since determination of the tensile strength/tensile elongation of the decorating sheet at rupture thereof requires measurements under a fixed load and under a constant rate of elongation, the temperature of the decorating sheet would have to be varied in a controlled manner so as to maintain the load to be fixed and the rate of elongation to be constant. The disclosure does not describe or explain how the temperature is varied in a controlled manner, and thus, the Examiner believes that the claims are not enabled by the specification.

A second basis for this rejection is that the Examiner believes that the specification does not disclose the thickness of the test specimen of the decorating sheet for which tensile strength/tensile elongation at rupture is measured.

This rejection is respectfully traversed for the following reasons.

With regard to the first basis of this rejection, please note that neither the specification nor claims require that the properties of the test specimen of the decorating sheet are measured under a "fixed" load and under a constant rate of elongation. Rather, the load applied to this test specimen is a load necessary for the test specimen to elongate at a constant rate. This is believed to be clear from page 22, line 22 through page 24, line 1 of the original specification.

Regardless, even though the claims do not require a "fixed" load, by the current Amendment each of independent claims 22, 39, 41 and 43 has been amended so as to more clearly recite the

properties exhibited by the test specimen of the decorating sheet. In this regard, clause (i) of each of independent claims 22, 39, 41 and 43 now recites

> when a 10 mm wide test specimen...is fixed between a pair of chucks at a chuck-to-chuck distance of 5 mm and then a load is applied to the test specimen at one end thereof under a temperature of from 62°C to 94°C such that the test specimen elongates at a constant rate of 500 mm/min, the test specimen experiences a tensile load at breakage thereof of at least 23 gf,

And, clause (ii) of each of these claims now recites

> ...when a 10 mm wide test specimen... is fixed between a pair of chucks at a chuck-to-chuck distance of 5 mm and then a load of 20 gf is initially applied to the test specimen at one end thereof, under a temperature between a first temperature within the range of from 40°C to 200°C and a second temperature at which the decorating sheet decomposes, such that the test specimen elongates at a constant rate of 500 mm/min, the test specimen exhibits a tensile elongation at breakage thereof of at least 130%.

Claim 23 has been amended in a similar manner.

No new matter has been added by these amendments, and accordingly, it is respectfully submitted that the specification and claims are in full compliance with 35 U.S.C. § 112, first paragraph, insofar as the first basis of the 35 U.S.C. § 112, first paragraph, enablement rejection is concerned. Thus, it is respectfully submitted that the first basis of this rejection should no longer be maintained.

With regard to the second basis of this 35 U.S.C. § 112, first paragraph, enablement rejection, please note that on page 33, lines 4-5, and 20-21, it is recited that the thickness of the decorating sheet is within a range of 50 to 2000μm, and preferably within a range of 250 to 700μm, whereby it is respectfully submitted that the second basis of this rejection should also no longer be maintained.

In view of the above, it is respectfully submitted that one having ordinary skill in the art would have been able to make and use the invention without undue experimentation. Thus, it is respectfully submitted that the 35 U.S.C. § 112, first paragraph, enablement rejection should no longer be

maintained. In any event, each of the independent claims has been further amended to recite that the thickness of the test specimen is **within the range of from 250μm to 700μm**.

The above discussion and amendments are believed to also address the 35 U.S.C. § 112, first paragraph, rejection as expressed in section 2 o f the Office Action, whereby this rejection should also no longer be maintained.

With regard to the 35 U.S.C. § 112, second paragraph, rejection as expressed in section 4 of the Office Action, the above discussion and amendments are also believed to address a main basis for this rejection. Additionally, with regard to the units "gf" being an improper unit for tensile strength at breakage, please note that clause (i) of each of independent claims 22, 39, 41 and 43 has been amended to recite that the test specimen **experiences a tensile load at breakage thereof of at least 23gf**. This amendment is believed to address and resolve the additional 35 U.S.C. § 112, second paragraph, issue raised by the Examiner. In view of the above, it is respectfully submitted the 35 U.S.C. § 112, second paragraph, rejection should not be maintained.

In sections 7-11 on pages 6-17 of the Office Action, the Examiner has basically repeated the prior art rejections while providing additional rationale for concluding that these rejections are proper. These rejections are respectfully traversed for the following reasons.

As expressed in section 12 on page 18 of the Office Action, a premise upon which the prior art rejections are based is that because the claims allow for "any" thickness of the test specimen, the claims can be broadly construed to read on any material that is capable of meeting the properties of the test specimen as claimed. As expressed above, the thickness of the test specimen has now been claimed, whereby it is respectfully submitted that this premise for the prior art rejections is no longer present such that the prior art rejections based on this premise should no longer be maintained.

Additionally, with regard to the alternative position taken by the Examiner as expressed on page 7, line 12 through page 8, line 21, the arguments as expressed on pages 4-7 of the Appeal Brief filed June 17, 2004, are hereby repeated to address the Examiner's reliance on JP '397 in rejecting each of independent claims 22, 39, 41 and 43.

In essence, Applicant's invention is based on determining properties of an in mold decorating sheet based on real processing conditions. The claims as currently amended are believed to limit coverage to such an inventive decorating sheet, its method of manufacture, or article including such

a decorating sheet, without encompassing subject matter not sought to be protected thereby. JP '397 fails to teach or suggest modification of some parameter of the material disclosed therein while taking into consideration real processing conditions so as to arrive at properties as recited in each of the independent claims.

Thus, it is respectfully submitted that each of independent claims 22, 39, 41 and 43 is allowable over any combination of the relied upon references, with JP '397 being a primary reference.

In view of the above amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and an early Notice of Allowance is earnestly solicited.

If after reviewing this Amendment, the Examiner believes that any issues remain which must be resolved before the application can be passed to issue, the Examiner is invited to contact the Applicant's undersigned representative by telephone to resolve such issues.

Respectfully submitted,

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AMENDMENTS TO THE DRAWINGS:

Replacement Formal Drawings for Figures 26 and 27 have been filed concurrently.